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**Supreme Court of the United States**

**October Term, 1940**

**No. 666**

**DETROLA RADIO & TELEVISION CORPORATION,**  
*Petitioner,*

*vs.*

**HAZELTINE CORPORATION,**  
*Respondent.*

**BRIEF FOR PETITIONER.**

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*Of Counsel.*

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IN THE  
**Supreme Court of the United States**

October Term, 1940

No. 686

DETROLA RADIO & TELEVISION CORPORATION,  
*Petitioner,*

*vs.*

HAZELTINE CORPORATION,  
*Respondent.*

**BRIEF FOR PETITIONER.**

This is a patent infringement suit here on writ of certiorari to the Circuit Court of Appeals for the Sixth Circuit.

The patent involved, held by the Sixth Circuit Court of Appeals to be valid and infringed, is Wheeler reissue patent No. 19,744, which was granted as a reissue of original patent No. 1,879,863 after the Court of Appeals for the Second Circuit had held the original patent to be invalid for want of disclosure of a patentable invention, and also after the District Court for the Eastern District of New York had held the original patent not infringed by the same device here held to infringe, in which decision Hazeltine acquiesced, taking no appeal.

**Opinions of the Courts Below.**

The District Court rendered no opinion in the case at bar; it merely filed findings and conclusions which are not reported, but will be found in Volume II, pages 839-859, inclusive. The opinion of the Sixth Circuit Court of Appeals is not yet reported but will be found in Volume III, at pages 1470, *et seq.*



The opinions of the District Courts of the Second Circuit involving the original patent will be found in 7 Fed. Supp. 908, and 8 Fed. Supp. 100.

The opinion of the Second Circuit Court of Appeals is reported in 79 Fed. (2d) 329.

### **Jurisdiction.**

The date of the judgment to be reviewed is December 9, 1940.

The writ of certiorari was granted by this Court on February 3, 1941.

The jurisdiction of this Court is invoked under the Judicial Code, Section 240(a), 28 U. S. C. 347, as amended by the Act of February 13, 1935.

Cases believed to sustain the jurisdiction are:

*General Electric Co. v. Wabash Appliance Corporation*, 304 U. S. 364;

*The Toledo Pressed Steel Co. v. Montgomery Ward & Co.*, 307 U. S. 350.

### **Statement of the Case.**

1. Respondent, Hazeltine Corporation (hereinafter referred to as Hazeltine) is the owner of the patent in suit. It is a patent holding company, the sole business of which is to acquire and own patent rights under which it grants licenses for royalties which comprise its sole source of income (Finding 12, R. Vol. II, p. 843).

2. Suit was instituted in New York by Hazeltine for alleged infringement of the original Wheeler patent, in which case the Court of Appeals for the Second Circuit held the patent to be invalid for failure to disclose a patentable invention (*Hazeltine v. Abrams*, 79 Fed. 329), affirming the decree of the District Court (7 Fed. Supp. 908). The record in the *Abrams* case is here as Defendant's Exhibit S (physical).

In a second proceeding in the Eastern District of New York, prior to the decision of the Second Circuit Court of Appeals, the District Court held the original patent not infringed (*Hazeltine v. R. E. B. Service Co.*, 8 Fed. Supp. 100). No appeal was taken by Hazeltine from the decree entered pursuant to this latter decision.

3. On September 26, 1934, while the appeal to the Second Circuit Court of Appeals was pending in the *Abrams* case, Hazeltine filed application for reissue of the patent based on alleged "inadvertence, accident or mistake" in procuring the original patent, as required by Section 4916 of the Revised Statutes,\* without then calling to the attention of the Patent Office the adverse decisions the patent had received in the Eastern District of New York, and without amendment, in any respect, of any of the claims of the patent other than by the cancellation of one of the twelve claims thereof (claim 9), which claim was not involved in the litigation (see Vol. III, pp. 998 *et seq.*, particularly pp. 1047-1049).

4. The appeal was prosecuted by Hazeltine, and after the adverse decision of the Court of Appeals above referred to (79 Fed. (2d) 329) Hazeltine redrafted the patent claims and advised the Patent Office that the amendments were made in the light of that decision (Vol. III, p. 1090).

5. Thereafter, on October 29, 1935 the reissue patent was granted.

6. On March 3, 1938 the complaint in the present case was filed against petitioner, Detrola Radio & Television Corporation (hereinafter referred to as Detrola).

Detrola is the manufacturer of the internationally known "Detrola" radio receiver, with its factory located at De-

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\* The full text of Section 4916 is reproduced as an appendix, p. 55.

troit, Michigan. Two of its receivers, known as Model 175 and Model 178, respectively, are charged to infringe. Detrola is licensed under all of the patents of the so-called "Radio Patent Pool".\* The specific feature of its receivers charged to infringe forms the subject matter of one or more of the patents under which Detrola is licensed, and which concededly antedate, and, it is contended (and held by the Second Circuit Court of Appeals) anticipate and invalidate the Wheeler patent.

7. This feature, employed by Detrola in its two challenged receivers, is the same as that which Detrola has used since before the application for reissue, and the same as that employed in one of the receivers held by the District Court in New York in the *R. E. B. Service* case, *supra*, not to infringe the original Wheeler patent, in which decision Hazeltine acquiesced.

8. In the case at bar the District Court for the Southern Division of the Eastern District of Michigan sustained the patent as valid and infringed, expressly declining to follow the decisions of the Courts of the Second Circuit (Vol. II, Finding 21, pp. 854-855).

9. The Sixth Circuit Court of Appeals affirmed the decree of the District Court.

10. Detrola here seeks a reversal of the judgment of the Sixth Circuit Court of Appeals because the Wheeler reissue patent is neither valid nor infringed.

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\*This patent pool consists of all of the patents relating to radio owned by the Radio Corporation of America, General Electric Company, Westinghouse Electric & Manufacturing Co., American Telephone & Telegraph Company, Western Electric Company, Bell Laboratories, and others, of which Radio Corporation of America is the managerial and licensing agent in the radio broadcast receiver field with which this case is concerned.



### **Assignment of Errors.**

The errors of the Circuit Court of Appeals for the Sixth Circuit are:

1. The Court erred in sustaining the Wheeler patent as valid.
2. The Court erred in sustaining the Wheeler patent as infringed.
3. The Court erred in holding, in effect, that an original patent which fails to disclose a patentable invention, may be validly reissued.
4. The Court erred in holding, in effect, that a decree of invalidity by a Circuit Court of Appeals, despite the patentee's most vigorous prosecution of litigation seeking a different conclusion, created an instance of "inadvertance, accident or mistake" in the procurement of the original patent such as is prescribed by the Reissue Statute as a prerequisite to a valid reissue.
5. The Court erred in failing to hold that the reissue patent had been improvidently granted.
6. The Court erred in failing to hold the reissue patent to be invalid because of unreasonable delay in applying therefor.
7. The Court erred in failing to hold the patent to be invalid for anticipation by and want of invention over the prior art.
8. The Court erred in failing to hold that defendant (Detrola) was possessed of intervening rights which precluded plaintiff (Hazeltine) from asserting the reissue patent against defendant.



### Summary and Order of Argument.

1. The Wheeler reissue patent is invalid because of anticipation by and want of invention over the prior art.
2. The patent is not infringed.
3. The Wheeler reissue patent is invalid as having been improvidently granted by the Patent Office because it was unwarranted by the Reissue Statute in that—
  - (a) the invalidity of the original patent, because it did not disclose a patentable invention, could not be cured by reissue.
  - (b) no facts were presented with the application for reissue from which it could have been determined that "inadvertence, accident or mistake" occurred in the procurement of the original patent, as is made by the statute a prerequisite to a valid reissue.
  - (c) the oath accompanying the application for reissue affirmatively establishes that no "inadvertence, accident or mistake" occurred in connection with the issuance of the original patent, and the only material averments therein were either admitted or proven to be false.
  - (d) Hazeltine has been guilty of unreasonable delay in applying for the reissue.
4. Detrola has intervening rights, in that its receivers charged to infringe are identical in every material respect with the receivers it manufactured prior to the application for the reissue patent, as well as with the Colonial receivers held not to infringe the original patent, in which holding Hazeltine acquiesced.

### Argument.

Before taking up specific consideration of the points of argument outlined above, it is necessary to have an understanding of the subject matter of the litigation, as well as of the Wheeler patent.

#### Subject matter of the case.

This litigation has to do with the control of the amplifying power of a radio vacuum tube, generally referred to in the art as a "vacuum tube amplifier". As this Court has had occasion to know,\* vacuum tubes have been utilized in the radio industry for a great many years.

The vacuum tube art began with what is known as a two-electrode or "diode" device, which, particularly in the early days of the art, was also frequently referred to as a "Fleming Valve". Such a device consists of a cathode (or filament) electrode and an anode (or plate) electrode, separated from each other within an evacuated glass bulb, with wire leads therethrough for external circuit connection. This two-electrode or diode device was used in the radio industry as a detector or rectifier (the two terms being used synonymously in this suit). In other words, this device would change the form or character of current supplied to it, from "alternating" current to "direct" current.

Thereafter, in about 1906, DeForest, by his invention of the "audion", supplied to the tube a third electrode in the form of a grid-shaped wire positioned between the filament and plate electrodes. This three electrode or "triode" device performed the same function of detection or rectification that had been performed by the diode device, but, in addition, it was capable of performing the function of "amplification". In other words, the three electrode or

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\* *DeForest Radio Co. v. General Electric Co.*, 283 U. S. 664.

triode device was capable of amplifying—strengthening—the current supplied to it without changing its form or character. Thus, alternating current of a particular frequency supplied thereto would be delivered therefrom as alternating current of the *same* frequency, but with greatly amplified strength.

Therefore, since the early days of radio, the art had available to it both two electrode (diode) and three electrode (triode) vacuum tubes. However, the three electrode tube became far more extensively—almost universally—used in radio receivers because, when used as a detector, it *simultaneously* functions as an amplifier.

The vacuum tube is an *inertialess* device, i. e., it has no moving parts. Therefore, in operation it performs its intended functions regardless of the particular character of the currents it is supplied with. For example, it amplifies currents regardless of whether they are of high or low frequency. Thus, it was and is customary to name the vacuum tube in accordance with the particular function it serves. For example, “radio amplifier” or “carrier frequency amplifier” are the names by which is called the vacuum tube serving as an amplifier of radio (high) frequency currents; “detector” or “rectifier” are the names by which is called the vacuum tube serving as the detector; and “audio frequency amplifier” is the name by which is called the vacuum tube serving as an audio (low) frequency amplifier. When the *triode* is used as a detector it is usually referred to simply as a “detector” or “rectifier” in spite of the fact that it simultaneously amplifies.

In a three electrode amplifier tube the *power* of amplification, generally speaking, is determined by the voltage impressed on the grid electrode thereof. This grid voltage is usually of a negative potential relative to the potential of the filament. Therefore, it was and is customary in the



art to refer to the voltage on the grid of an amplifier tube as a "negative bias", "grid potential" or "grid bias". When there is an *increase* in the *negative* potential or grid bias of an amplifier tube, the amplifying power of the tube is proportionately *decreased*. Conversely, when there is a *decrease* in the negative potential or grid bias of an amplifier tube, the amplifying power of the tube is proportionately *increased*.

From this it will be seen that the amplifying power of any vacuum tube amplifier can be regulated by controlling the negative bias or potential on the grid electrode thereof. This fact has been known since the advent of the three electrode tube amplifier in the first decade of the twentieth century, and it has been universally utilized, ever since, to control vacuum tube amplification.

The present case has to do solely with this old, well-known principle of controlling the amplifying power of a vacuum tube amplifier by controlling the grid potential thereof.

#### **The Wheeler Reissue Patent.**

All that the patentee proposed to do was to control the amplifying power of a vacuum tube amplifier in a radio signalling system by regulating the negative bias on its grid—a practice which, as stated above, had been universally known and followed for years before him. However, he proposed to do this *automatically* by means of the signal current passing through the system. That was his supposed contribution. The idea was that if, for any reason, there would be an excessive increase or *surge* in the current passing through the system, that excess above normal would be utilized to proportionately *increase* the negative grid bias of the amplifier tube to thereby proportionately *decrease* the amplifying power thereof, and *vice versa*.



That, in brief, is the alleged invention of the patent; and the Second Circuit Court of Appeals found, and it will be shown hereinafter, that the prior art completely anticipated Wheeler in such conception; even if it involved invention, which it did not.

Wheeler chose to illustrate his invention as applied to a broadcast radio receiver, such as is used in the home, although it is here noted that particular pains were taken in his behalf to carefully frame some of the patent claims (*e. g.* claims 2 and 5, III, 873) so as to recite merely a "signaling system", to thereby include *any* system (transmitting, receiving, amplifying, etc.) in which a vacuum tube amplifier is employed.

Referring to Figure 1 of the patent (III, 867), which is a schematic layout of a six tube radio broadcast receiver of a standard type, there is shown an antenna (5) electrically associated with a series of three radio frequency amplifiers (9, 15, and 23), so that the received radio frequency signal current is passed through and amplified by each of them successively, and is then delivered to the detector or rectifier tube (33), to be thereby converted or changed into audio frequency currents which are then passed through the low frequency vacuum tube amplifiers (39 and 47) to the loud speaker (50) in the usual well known way. All of this was standard at the time of the Wheeler application.

It will be noted that the detector tube (33), though illustrated as a three-electrode (triode) device, has its plate and grid electrodes (35 and 12) connected together so that they are, in electrical effect, a single electrode, thus making this device a two-electrode (diode) vacuum tube which, though capable of functioning as a detector or rectifier, has thereby been deprived of its ability to serve as an amplifier.

It is the control or regulation of the amplification of the *first* radio amplifier tube (9) that is effected in the arrange-

ment of Figure 1 of the patent, although such control can be effected on as many amplifier tubes as are employed, and Figure 3 of the patent shows an arrangement whereby control of the amplification of the first *two* of the three radio frequency amplifier tubes is effected. In *each* instance, however, such control is effected by biasing the grid of the vacuum tube amplifier, or amplifiers, by means of a voltage obtained from the output circuit of the detector (33), and supplied to the amplifier grid by a direct electrical connection through the wire (36), with a resistance (51), as usual, included in the circuit of the detector. As will be later shown, the art prior to Wheeler disclosed this precise circuit for this precise purpose.

Thus, the radio signal current is received by the antenna and passed through the radio frequency amplifier tubes to the detector tube where it is rectified and fed through the audio frequency amplifier tubes to the loud speaker. However, a direct current component of the rectified signal current is fed, as a voltage, to the grid electrode of one or more of the radio frequency amplifier tubes, to increase or decrease the bias thereof, and, in consequence, the amplifying power of the amplifier, thus automatically maintaining the volume of reproduced sound substantially uniform regardless of variations in the strength of the signal current.

#### The claims.

All of the claims except No. 8 are in suit. At the trial Hazeltine's counsel selected claims 1 and 10 as typical. It is necessary to refer to but one of these in detail.

Claim 1, analyzed with reference to Fig. 1 of the drawing, consists of a signal receiver having

(1) a carrier (radio) frequency amplifier which includes at least one vacuum tube having a cathode and a control electrode (the radio frequency amplifier 9);

(2) a two-electrode (diode) rectifier coupled to the output circuit of said amplifier (the detector 33);

(3) a high resistance connected between the rectifier anode and the amplifier cathode (the resistance 51 is connected between the anode of the detector 33 and the cathode. The cathodes of all of the tubes are connected together so that a connection to one is a connection to all);

(4) means including said resistance for maintaining the average potential of said anode normally negative relative to at least part of said amplifier cathode and increasingly negative with increasing amplifier signal output from said amplifier (this consists of the resistance 51 in conjunction with the rectifying action of the detector tube); and

(5) a direct-current connection from said anode back to said amplifier control electrode whereby the amplification of said amplifier is regulated automatically (this connection is the wire 36).

Claim 10 differs from claim 1 primarily in being more prolix. It defines the same elements defined in claim 1, and in addition recites a "no more selective" coupling between the amplifier and detector (which is not described or mentioned in the specification), and the "time constant" which was discussed in the opinion of Judge LEARNED HAND in the *Abrams* case at 79 F. (2d) 331. Both of these features are concededly old in the prior automatic amplification control art.

From this it will be seen that what is claimed as the invention of the patent, reduced to its simplest terms and expressed in non-technical language, is the control of the amplifying power of a vacuum tube amplifier by supplying



to its grid electrode a biasing voltage, obtained from the output of a diode detector (provided with its usual external resistance), to which the amplifier supplies the current passing through the system, by means of a direct connection, so that the regulating voltage utilized to control the grid bias of the amplifier will be varied in negative potential as the current passing through the system varies in strength.

Thus, in the particular application of the invention to a radio receiver, a substantially uniform volume is obtained for the reproduced signal, as is illustrated in the amplification curve constituting Figure 2 of the patent. This curve illustrates graphically in full line (103) the operational characteristic of the invention, and represents the optimum results claimed to be secured thereby. This graph is of particular interest because, as we will see in discussing the prior art, the *identical* graph is utilized in several instances thereof, showing that *identical* results were obtained in the prior art by the same means.

The automatic control of the grid bias of an amplifier tube is termed by the reissue patent and its claims (*e. g.*, claim 1) "automatic *amplification*" control or regulation, which again emphasizes the fact that the alleged invention of Wheeler is not concerned with whether or not such control or regulation of an amplifier is utilized for controlling the volume of the loud speaker of a radio receiver, or for some other purpose in some other type of system.\* Therefore, as a matter of convenience and to avoid needless repetition, resort will be had to the practice, common in the radio art, of hereafter indentifying the "automatic amplification control" of the Wheeler patent by the initials of the term, viz: "a. a. c.".

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\* Emphasis in quotations throughout this brief is ours.



# POINT I.

**The Wheeler reissue patent is invalid, because of anticipation by and want of invention over the prior art.**

The patent here involved is identical in its disclosure of diode a.a.c. with that of the original patent.

The Second Circuit Court of Appeals, considering the disclosure of the original patent as a whole, found it to be invalid because it did not disclose a patentable invention. That Court said, with reference to one instance of the prior art there (and here) before the Court (79 Fed. (2d) 329, 330):

**"At any rate, both in principle and means the invention anticipated Wheeler; \* \* \*"**

Again the Court said (p. 330):

**"The problem of the automatic control of amplification to correspond with variations of amplitude of the carrier current had been solved, and the basic means were known; Wheeler used that means"**

Again, in discussing inconsequential difference in details between Wheeler and the prior art, the Court said (p. 331):

**"the art did not have to wait long for the change. Nor does it seem to us that when it came, it involved invention."**

Concluding, the Court said (p. 332):

**"We put this patent down as one of those step-by-step advances, not beyond the compass of capable investigators who run down every lead and cull out those which appear advantageous."**

The factual support for the conclusion of the Second Circuit Court of Appeals above expressed will now be established by a consideration of a few of the patents of the prior art, all of which establish beyond doubt complete anticipation of, or want of novelty or invention in the patent in suit.

Before taking up specific consideration of these prior patents, however, the fact is again emphasized that Detrola is licensed under each and every patent to be considered.

**Evans Patents 1,736,853 and 1,899,323 (III, 127-1294).**

The disclosures of these patents were discussed by Detrola's expert Kelley in Vol. I, pages 239-261.

It will be noted that the application for the first of the Evans patents was filed on September 24, 1923—nearly four years prior to the application for the patent in suit; and it is stipulated for the purposes of this case that the application as filed is the same, in all material respects, as the patents as issued (I, 217, 218).

The second of these patents is a division of the first, and because its disclosure is confined to the automatic amplification control feature (which was, of course, disclosed in the original patent application, but only as one part of a complicated system), specific consideration will here be given only to the divisional application as a matter of convenience.

The specifications make it clear that the object of the invention of the Evans patent is to effect automatic amplification control, and that it is effected by the same means disclosed by Wheeler. Indeed, the specifications comprise a complete, detailed and clear exposition of everything disclosed by Wheeler. Thus, in Evans (III, 1294), the incoming signal is supplied to the apparatus through the connection (1, 2) at the right of the figure. It passes through the

radio frequency amplifying tubes (5) and (4) in series, and is delivered by the output of the last of these tubes to the input of the detector tube (8), which passes on the rectified current for its intended purpose through the transformer (10). The output or plate circuit of the detector tube (8) is provided with a resistance (19) between its anode and the amplifier cathode, and there is a direct current connection from the anode back to the control or grid electrodes of both of the radio frequency amplifying tubes (4) and (5). Thus, there is complete identity in purpose, instrumentalities, operation and result between the Wheeler and Evans patents.

It is true that in the drawings of the Evans patent the detector (8) is shown as a three-electrode device used as such, whereas in the Wheeler reissue patent the grid and plate electrodes of the three-electrode detector are connected together so that it is used as a diode. But the Evans patent plainly suggests that a diode can be utilized in lieu of a triode—were such a suggestion necessary in view of the common knowledge of the art that the use of a diode as a detector preceded the use of a triode for that purpose, and a diode was *never* used *except* as a detector. Thus, on page 1 of the specifications of the Evans patent it is recited (line 78) that each of the *amplifying* tubes 4 and 5—

“comprises an anode, a cathode, and a grid or control element”

thereby, specifically and properly describing *amplifying* tubes which, as we have shown, were necessarily triodes. But in the next sentence the *detector* is described as

“A detector or rectifier space discharge device 8.”

Thus, the patentee *refrained* from describing the detector as a triode, and a diode was the only “space discharge device” known to the art as a detector other than the triode



which succeeded it in time and supplanted it in use (see Kelley I, 234, 255). Moreover, that this language was intentionally and carefully chosen for the purpose of *suggesting* the use of either a diode or a triode as a detector, and to include them both, is conclusively evidenced by the claims of the Evans patent. For example, claim 3 recites the amplifier and rectifier tubes as "each" comprising a grid, a cathode and an anode, viz: a triode tube. Obviously, this claim was directed to the specific instrumentalities shown by the drawing. However, claim 10 distinguishes therefrom by defining only the *amplifier* as a three-electrode device, and reciting the detector merely as "a rectifier". Obviously, this claim was directed to include the use of either a diode or a triode as the detector (Kelley I, 256).

As a matter of fact, whether or not a diode or a triode is used as the detector for years prior to Wheeler had been known to be merely a matter of choice. Each had its own advantages as well as disadvantages, *as is expressly pointed out in the original Wheeler patent* (III, 1074-A). As has already been stated, a triode has the advantage that in addition to performing its detecting or rectifying function it can likewise serve as an amplifier. The disadvantage in its use is that all triode amplifiers require a current source (known in the early days of the art as a "B" battery) connected between the plate electrode and the filament electrode. It sometimes is disadvantageous (and certainly was in the early days when the only current sources usable were *batteries*) to be put to the necessity of employing an additional battery. As compared to this the use of a diode had the disadvantage that it sacrificed amplification, with the compensating advantage that it eliminated the necessity for the additional battery. It is not disputed that all this was known many years prior to Wheeler (Hazeltine I, 475-477; Kelley I, 255-258).

Moreover, that for a.a.c. purposes the use of a triode detector is an optional equivalent of a diode detector is also indisputably evidenced by the original Wheeler patent (III, 1067 *et seq.*). Of the six circuitual figures of the original patent disclosing Wheeler's "invention", three thereof (Figs. 4, 5 and 6) show triodes as the detector, and each of them is stated (*e. g.* p. 1071, line 95; p. 1071-a, lines 5 and 6) to disclose "the present invention" of Wheeler. Figure 4 is stated (p. 1073, line 103) to operate in "substantially the same manner" as Figures 1 and 3 of the original patent (which are the only circuitual figures incorporated in the reissue); and it is further stated that "the advantages of the present invention are especially apparent in systems such as Figures 6 and 7" which employ a triode and a diode rectifier respectively (p. 1074-a, lines 16-28).

Furthermore, in the application for the original patent Wheeler argued "The invention can obviously be used with *any kind of a detector*" (III, 1175).

Finally, although Wheeler presented claims directed to the use of a diode as distinguished from a triode during the pendency of his application for the original patent (claims 5, 6, 7, 8, 9, 18, 23 and 24, III, 1152-1156, 1168), *all* of such claims were repeatedly rejected by the Patent Office Examiner as presenting no patentable distinction over the triode (III, 1164, 1182); *Wheeler acquiesced in this rejection and cancelled all of the diode claims* (III, 1166 for claim 5, and 1184 for the remaining claims). It was not until August 18, 1932, *after the application was allowed with no claims directed to diode a.a.c.*, that Wheeler again presented claims directed to a diode detector (claims 28 and 29, III, 1189), which issued as claims 11 and 12 of the original patent, on the assertion that they were "practically the same" as claim 1 of the original patent—a *triode detector claim* (III, 1190).

Even if there were a valid distinction between diode and triode a. a. c., the patentee, having set them up as *equivalents* in order to monopolize them both, is bound thereby and cannot escape the anticipating effect of a prior disclosure of either of them, by *now* asserting that his inventive concept was the realization of the advantages of one over the other.\*

The Court of Appeals for the Second Circuit, in the *Abrams* case, ruled squarely on the want of any material difference between using a diode or triode in an a. a. c. system. The Court said (79 Fed. (2d) 329, 331)—

"Again as to Wheeler's triode used as a diode, it was an old device; Heising had used a diode in a not dissimilar setting and that is not to be distinguished from a triode used as a diode. When, as in a receiving set, compactness becomes an end, why not eliminate the 'B' battery necessary to a triode?"

Defendant's Exhibits W and X (III, 1342, 1343) show the Evans a. a. c. circuit under both conditions—Exhibit W with a triode detector, and Exhibit X with a diode detector. It will be seen that the *only* difference is in the elimination of the "B" battery (16) which, as was well known, must be used with a triode in order to enable it to amplify, but which, as was likewise well known, is unnecessary with a non-amplifying diode.

Moreover, as will later be shown, the Evans circuit is the same in every material respect with that employed in defendant's receivers.

Finally, an application of the Wheeler claims—using claims 1 and 10 as typical—shows that they read, element

\* *Kissock v. Duquesne Steel Foundry Co.*, 37 Fed. (2d) 249, 252 (C. C. A. 3); *Hamilton Laboratories Inc. v. Massengill*, 111 Fed. (2d) 584, 585, 588 (C. C. A. 6).



for element, squarely on the Evans disclosure (Kelley, I, 248-252). In consequence, the Evans patents are complete anticipations of Wheeler. This fact is emphasized by reference to the claims of the Evans patent (III, 1297). It will be seen that Evans actually *claims* the invention which the Wheeler patent is advanced as covering (*e. g.* claim 10. The "gain control" of Evans and the "amplification control" of Wheeler are wholly synonymous).

The Court below held (III, 1480) that the Evans patents failed to anticipate Wheeler, on the ground that Evans discloses a triode incapable of producing linear rectification, whereas Wheeler's *invention* is in the use of a diode with a high resistance producing linear rectification. This is wholly erroneous for each of the following reasons:

(1) The patent in suit is *not* limited to a diode, claims 2, 3, 6 and 9 being drawn to include a triode;

(2) The patent in suit is *not* limited to a high resistance, claims 2, 3, 4, 6, and 9 not including this feature;

(3) The Evans patents are *not* limited to a triode, a diode being also contemplated and claimed as we have shown above;

(4) Evans also discloses the use of a resistance in conjunction with a diode or triode;

(5) Wheeler disclosed in his original patent (III, 1069 *et seq.*) that a diode and a triode are equivalent, and cannot now avoid anticipation by asserting otherwise;

(6) Wheeler's other patents, 1,879,861 (III, 1355 *et seq.*) and 1,879,862 (III, 1361 *et seq.*), divisions of the same original patent as is the patent in suit, disclose *only* triode *a.n.c.* and expressly claim a triode (III, 1359, 1364), and these claims have never been disclaimed (I, 500, 501). This

shows conclusively that Wheeler *still* considers them equivalent;

(7) Hazeltine's expert *expressly* admitted that the Evans circuit would produce linear rectification (I, 489, 490).

### Heising Patent No. 1,687,245 (III, 1272).

The disclosure of this patent was discussed by Detrola's expert in Volume I, pp. 271-275.

This patent shows the application of a.a.c. to a transmitting system, wherein the rectifier (11) is shown as a diode, with three-electrode amplifying tubes (7, 5) connected in series with each other, and respectively, with the input and output of the rectifier. Here, again, there is a resistance (12), as in Wheeler, between the anode or plate electrode of the rectifier and the cathode of the amplifier, and a direct-current connection from said anode to the grid or control electrodes of each of the amplifying tubes (5), for the purpose, as made clear by the specification (*e. g.* p. 3, lines 22, *et seq.*) of automatically varying the potential of the grid of the amplifiers in accordance with the current passing through the rectifier—in other words, *automatic amplification control*.

The resistance (12) of Heising, included in the circuit between the anode of the *diode* rectifier and the cathode of the amplifier, is described in the specification of the patent (p. 3, line 39) and claimed in the claims thereof (*e. g.* claim 6) as a "high" resistance—the identical thing (in conjunction with a diode rectifier) advanced by the reissue patent and held by the Court of Appeals below to constitute Wheeler's invention. Moreover, and quite contrary to the decision of the Court of Appeals below, *Hazeltine's* expert categorically admitted (I, 491) that Heising effects

*automatic amplification control*—the precise result sought by the Wheeler patent.

The Court below distinguished Wheeler from Heising on the ground that Heising's device is for use in a *transmitter* (III, 1480), overlooking the fact that claims 2, 3 and 5 are drawn to *include* a transmitter, as was expressly held by the District Court in the *Abrams* case at 7 Fed. Supp. 914 in considering the same language ("signalling system") used in the claims there in issue. The Second Circuit Court of Appeals quite properly found that there was no patentable distinction in an *a.c. circuit* because of its use in a receiving rather than in a transmitting system. The *circuit* was obviously the same, and its function was identical.

So, here again, it is seen that the Wheeler patent is devoid of any element of novelty, even down to the tenuous detail of employing a diode rectifier (instead of a triode) in conjunction with a *high* resistance.

**Affel Patent No. 1,574,780 (III, 1246).**

This patent was discussed by Detrola's expert at Vol. I, 263-266.

This is another patent which is expressly directed to automatic amplification control, one of its stated objects being (p. 1, line 19)—

*"to control the amplification of an amplifying device directly by the amplitude of the input current supplied by the device."*

In this instance, a three-electrode rectifier RT is employed, the anode or plate electrode of which is connected through a resistance (4) to the cathode of the amplifier AT, and there is a direct-current connection from the anode of RT to the grid of AT. In this arrangement Affel utilizes



the incoming wave to automatically control the amplifier tube prior to, instead of after, being passed through the amplifier tube.

The Affel patent is also of particular interest because it shows, in Fig. 5, *the identical amplification curve disclosed by Figure 2 of the Wheeler patent (III, 867)*. In other words, both systems accomplish the same result of automatically controlling amplification so that substantially uniform amplification is attained.

It will be seen, therefore, that there is nothing whatever in the disclosure of the Wheeler patent that is patentable over the prior Affel patent, as was held by the Second Circuit Court of Appeals at 79 Fed. (2d) 331, column 1.

#### **Friis Patent 1,675,348 (III, 1266).**

This patent was discussed by Detrola's expert at Vol. I, 261-263.

It, too, shows and describes automatic amplification control in a radio receiver. The opening paragraph of its specification recites:

"This invention relates to radio receiving systems and more particularly to methods of and means for controlling the intensity of received signals at a uniform level."

This will be immediately recognized as automatic amplification control, and as being applied to the same type of system (a radio receiver, to control the *volume* of the received signals), as was selected by Wheeler to illustrate a practical application of his alleged invention. It is accomplished in precisely the same manner as proposed by Wheeler, in that current obtained from the output circuit of the amplifier (3) is rectified, and a direct current component thereof is supplied to the grid of the amplifier for regulat-

ing the bias on the grid, thereby to control the amplification of the amplifier. This is accomplished in the identical manner and for the identical purpose as described by Wheeler. It will be noted, as stressed by Wheeler, and as is common to all a.a.c. circuits, a resistance (18) is provided in the output circuit of the rectifier (16) supplying the control voltage to the amplifier grid.

In the Friis system, a separate and additional rectifier or detector tube (16) is employed for a.a.c., i.e., separate from and additional to the detector of the receiver which is merely schematically indicated at (7) in the drawing. This, of course, is a mere detail in circuit arrangement.

The disclosure of this patent is also of interest because it, too, shows in Figure 3 the operational graph *identical with that constituting Figure 2 of the Wheeler patent*, graphically establishing the complete identity in operation and results.

Actual construction and use by the Western Electric Company of the Friis arrangement has also been established by the testimony (Plaintiff's Exhibits 27, 28). This structure, built and used by the Western Electric Company prior to Wheeler's date of invention, was identical with the structure shown in the Friis patent except that it omitted the elements (13) and (14) shown in the patent. These elements constitute a refinement of detail which is not shown by Wheeler and are, therefore, immaterial to the question of validity of the Wheeler patent. Moreover, in the structure built by Friis, he used a high resistance and obtained linear rectification (III, 1392). This fact was overlooked by the Court below, which erroneously held to the contrary (III, 1480).

It is apparent, therefore, that the Wheeler patent possesses no patentable novelty over Friis.

**Slepian Patent No. 1,455,768 (III, 1233).**

This patent was discussed by Detrola's expert at Volume I, pages 266-271.

This patent is another complete anticipation, element for element, of everything shown, described and claimed by Wheeler. The a.a.c. circuit has been shown in a simplified manner in defendant's Exhibit Y (III, 1344). From this it will be seen that there is a resistance (9) between the rectifier anode and amplifier cathode, and a direct-current connection from the anode of the rectifier (18) to the grid of the three-electrode amplifier. An application of the Wheeler claims to the Slepian disclosure shows complete identity and anticipation (Kelley I, 270).

The Court below held that Slepian's purpose was "entirely distinct" from Wheeler in that he did not disclose automatic amplification control (III, 1480). *Hazeltine's expert testified squarely to the contrary* (I, 490-491).

**Summary and Conclusion as to the Prior Art.**

It is believed that the foregoing brief consideration of but a few instances of the prior art is sufficient to establish beyond the possibility of doubt that the Wheeler patent is completely anticipated by and lacks patentable invention over what preceded it in the art, as the Second Circuit Court of Appeals quite properly held. This, alone, warrants a reversal of the Court below.

**POINT II.**

**Detrola Receivers Models 175 and 178 do not infringe.**

When Hazeltine instituted suit in New York on the original Wheeler patent, its position was that Wheeler had made a basic invention. Automatic amplification control was ad-



vanced to the New York Courts as being basically new in conception and unheard of in the art prior to Wheeler, and that the original patent covered any and all means by which automatic amplification control was effected. It was only by such assertion that Hazeltine could have hoped to be successful in holding as infringements the Emerson, Bosch, RCA, and Colonial receivers involved in those litigations, all of which differed radically from the particular circuit arrangement proposed by Wheeler.

After the decision of the Second Circuit Court of Appeals, however, the tune changed. It was *then* asserted that automatic amplification control was, indeed, old in the art prior to Wheeler, and that his invention was *not* that basic conception. To the contrary, what Wheeler had done was to supply a *specific* way of achieving an *old* result, and that all that he wanted was a patent for his *specific* circuit for doing it. The *specific circuit* which, *alone*, was *then* advanced as novel, with Wheeler consisted of a diode detector (which we have already shown was not novel at all) and a high resistance connected between the rectifier anode and the amplifier cathode (which we have likewise shown was old). That was the story Hazeltine told the Patent Office to induce the grant of the reissue claims. That is likewise the story Hazeltine told the District Court below at the outset of the trial, and then proceeded to claim infringement by Detrola Models 175 and 178, neither of which, *concededly*, employs Wheeler's a.a.c. circuit (Hazeltine, I, 474).

The circuit diagram of the Detrola receiver, Model 175, will be found in Volume III at page 883, and a simplified layout of the a.a.c. circuit at page 1340. Similarly, the circuit diagram of the Detrola receiver, Model 178, will be found at page 886, and a simplified layout of the a.a.c. circuit at page 1341.

Referring to the wiring diagram of the complete receivers (pp. 883, 886), it will be seen that they both employ a radio frequency amplifier tube type 6A7, a detector tube type 75, and audio frequency amplifying tubes types 42 and 41, respectively. However, the detector tube is neither a two-electrode device nor a three-electrode device. To the contrary, it is a *five*-electrode device.

When vacuum tubes were first originated, all current sources for them (both to heat the cathode or filament electrode and to supply the plate or space discharge current in the plate-filament circuit) were supplied by direct current batteries. The engineers in the art, however, worked rapidly and effectively towards the goal of enabling the use of alternating currents obtainable from any electric light outlet. This was ultimately accomplished prior to any date with which we are here concerned, and the market was supplied in quick succession by so-called a.c. (alternating current) vacuum tubes, "indirectly heated" cathode tubes, and "screened grid" tubes. With the advent of these important developments, it soon became possible to combine the functions of several tubes in a single glass envelope. There was thus developed the "multi-purpose" tube, i.e. one containing a large number of electrodes operating in conjunction with but a single cathode, and all positioned in the evacuated space within a single glass envelope. One such type of multi-purpose tube, viz: Type 75, is employed in both Detrola receivers. However, both of typical claims 1 and 10 are expressly limited to a two-electrode (or diode) rectifier (or detector). It is apparent at the outset, therefore, that the claims are not infringed for this reason alone.

Likewise, both of typical claims 1 and 10 recite as an element—

"a high resistance connected between the rectifier anode and the amplifier cathode".

It is perfectly clear from the drawings of the Wheeler patent (III, 867) what is meant by this, and there is no dispute about it. It refers to the resistance (51) that is connected between the anode of the rectifier (35) and the filament (38). (It will be noted that the filaments of *all* of the vacuum tubes are connected in parallel to a single battery "A" so that a connection to *any* filament electrode is a connection to *all* of them.) *Nothing* is interposed between the terminals of the resistance (51) and the electrodes of the vacuum tube. The resistance is, unequivocally, "connected *between*" those two elements.

Referring to the wiring diagram of the Detrola receivers, however, (and preferably to the unquestioned simplified drawings thereof—III, 1340, 1341), it will be seen that the resistance (marked for ready identification by the same reference numeral 51) is in *no sense* "connected *between*" the electrodes of the tube. To the contrary, although one terminal thereof is connected to the filament, *the other terminal is connected to the inductance 31*. In other words, *an oscillation circuit* is connected between the resistance and the vacuum tube anode so that the resistance is *not* connected between the anode and the cathode. It will thus be seen that the automatic amplification control circuit of the Detrola receivers is different from that of the patent. This was positively testified to by defendant's expert Kelley (I, 287) and admitted by plaintiff's expert Hazeltine (I, 473). This, moreover, is not a mere colorable difference. Quite to the contrary, it was intentionally designed in the Detrola receivers for a definite purpose and function which necessitated a *different* a.c. circuit from that of the Wheeler patent. This will be clear from the following: Page 2, line 46 (first column) of the Wheeler reissue patent recites (III, 870):



"The output circuit of the rectifier 33 includes what may be termed a 'rejector' circuit for stopping radio frequency currents which have passed through the rectifier, and consists of a network including a resistance 34 and a bypass condenser 37 connected between the anode 35 and the filament 38 of the rectifier".

The purpose of this rejector circuit was succinctly stated by Detrola's expert Kelley (I, 286, 287), and its utilization characterized as

*"absolutely essential with the type of automatic amplification control circuit employed by Wheeler"*.

It is because Wheeler utilizes a resistance (51) "connected *between* the rectifier anode and amplifier cathode" that it is *necessary* for him to employ a rejector circuit. This was admitted by Hazeltine, who testified (I, 457):

"The resistance 51, therefore, of the Wheeler patent received across it the full value of high frequency signal potential, and that *necessitated* a relatively powerful filter for high frequencies; so that in the Wheeler patent the resistance 34 and the condenser 37 constituted this radio frequency filter and it was *necessary* to make a powerful filter by making the resistance 34 relatively large as Wheeler did."

As compared to this, the a.a.c. circuit of the Detrola receivers employs no rejector circuit, as was likewise categorically admitted by Hazeltine (I, 457):

"In the defendant's apparatus the resistance 51 being in parallel with the condenser 2 received only very little of the high frequency signal because the high frequency signal current could pass through the condenser 2 with very little opposition. *So that, the necessity for a powerful filter was not present.*"

Consequently, the Detrola receivers are simplified by the *complete omission* of any rejector circuit, made possible because the a.a.c. resistance is *not* "connected *between* the rectifier anode and the amplifier cathode", as specifically recited in each of the typical claims.

A resistance is employed in the Detrola a.a.c. circuit solely to insure that the regulating voltage is of negative potential—the *identical* purpose for which it is employed in *every* instance of the prior art above discussed. Moreover, it is employed by Detrola in the *identical* circuit arrangement that is employed in the prior patents.

It will be seen from the foregoing, therefore, that regardless of all questions of validity, neither of the Detrola receivers infringes the patent.

The subject of infringement, however, may be approached from a different viewpoint. With it perfectly obvious, and categorically admitted, that the Detrola a.a.c. circuit is different from that of Wheeler, the fact that it is *identical* with those of the prior patented art under which Detrola is licensed would seem to be conclusive and dispositive of this issue. This identity is present (Kelley, I, 249, 257, 263, 269, 274, 296-8), and may be clearly seen by simple comparison of the simplified wiring diagrams of the Detrola receivers (III, 1340-1341) and the prior Evans and Slepian patents (pp. 1342-1344).

On the foregoing facts, it is believed little necessity for argument exists. One of two conclusions seems inescapable. If the claims of the Wheeler patent are capable of an interpretation sufficiently broad to include the Detrola receivers, then anticipation is complete and literal by Evans and Slepian of the prior art. If, on the other hand, the claims are construed to be possessed of *any* element of difference over Evans and Slepian, there can be no infringement by

the Detrola a.a.c. circuit because of its identity with that of Evans and Slepian.

The Court below dismissed the subject of non-infringement with the terse comment that Detrola's contentions had "no merit", completely disregarding the undisputed facts.

#### **The Question of Commercial Success.**

We cannot close the consideration of the merits of the Wheeler patent without comment upon Hazeltine's argument of "commercial success" which so greatly impressed the Court of Appeals below, but which was quite properly adjudicated to have been without merit by the Second Circuit Court of Appeals in the *Abrams* case.

Here are the facts:

On August 19, 1926, Wheeler presented his invention to a meeting of Hazeltine's licensees, and had a set on display to demonstrate it (III, 975). Any of these licensees could have used the invention if it had wanted to without the payment of an additional cent of royalties (I, 178). *In spite of this fact not a single one of them made use of diode a. a. c. until 1929.*

We need not speculate as to the reason for this remarkable lack of interest in what is now asserted as an epoch making advance. Kelley made it perfectly clear (I, 228-229). In fact, the Chief Engineers of these licensees, testifying in behalf of Hazeltine, admitted that they did not use diode a.a.c. because in those days amplification was hard to obtain, and they needed every bit of amplification they could get. A triode rectifier gave amplification as well as detection, and therefore diode a.a.c. was of no practical utility in a radio receiver *until the advent in 1929 of the screened grid tube with the additional amplification which it provided* (Graham, II, 526; Cotter, II, 555; Johnston, II,



565, 567; Curtis, II, 579; Farrand, II, 601-2; also see Friis, II, 654, MacDonald, II, 625, and Wheeler, I, 153, 161, 166, 177-8). The first use asserted to have been made of the Wheeler "invention" was by the Philco Company in its Model 95 in 1929, which employed the screened grid tube, and every use of *diode* a.a.c. in radio receivers has been with the screened grid tube. In fact, plaintiff's chart (III, 890) intended to show commercial success for the present invention unwittingly betrays the total lack of utility therefor until the screened grid tube was invented. Wheeler's *diode* a.a.c. was therefore impractical and worthless in a radio receiver until this subsequent invention was made, and the record clearly shows that Wheeler himself realized this (see *ante*, p. 18).

The "commercial success" of *diode* a.a.c. is therefore seen to be due entirely to developments not made by Wheeler, not foreseen by him, and not realized by him until after they had occurred. He just happened to have in the Patent Office a chance disclosure with which, by shifting his position, he could claim to be responsible for the consequences of the screened grid tube development of others. Therefore, Hazeltine's claim of commercial success is untenable.

### POINT III.

The Wheeler reissue patent is invalid as having been improvidently granted by the Patent Office, because it was unwarranted by the reissue statute.

#### Introduction.

Notwithstanding the fact that either of the first two points of argument is completely dispositive of this case, and requires a reversal of the Court of Appeals below, we urge this Court to also pass upon the questions here presented involving current and widespread illegal prac-

tices under the Reissue Statute; and to condemn such practices in terms which will forever put an end to them. We urge this because the facts of the present case make it an outstanding example of abuse of the patent privilege indulged in by a corporation, whose sole activity and function is to acquire a large number of patents to form the basis for exacting a tribute from an industry to which it contributes nothing, as the price for freedom from expensive, continuous and unlimited patent litigation. What is believed to be its most relevant patent is used for this litigious purpose against one who dares to stand his ground, and after the patent is judicially declared to be worthless the Reissue Statute is then utilized as a means for skillfully remodeling the patent, which, as reissued, is continued to be used as a threat to the industry.

#### **The Reissue Statute.**

It is, of course, fundamental that "patent property is the creature of statute law, and its incidents are equally so, and dependent upon the construction to be given the statutes creating it and them, in view of the policy of Congress in their enactment" (*Brown Die & Tool Co. v. Nye Tool and Machine Works*, 261 U. S. 24).

Thus, the reissue of a patent can be effected only in the circumstances and for the reasons prescribed by the reissue statute (Section 4916 R. S.).\*

The statute recites that its remedial benefits can be availed of only when the original patent—

"is wholly or partly *inoperative* or *invalid*, by reason of a *defective* or *insufficient specification*, or by reason of the patentee *claiming as his own invention or discovery more than he had a right to claim as new*, if the error has arisen by *inadvertence, accident, or*

\* The complete statute is reproduced as an appendix hereto, p. 55.

*mistake*, and without any fraudulent or deceptive intention."

Even then, the statute prescribes that the reissue must be "for the same invention" as that disclosed in the original patent.

From this it will be seen that the fundamental prerequisite to a valid reissue is that "inadvertence, accident or mistake" has occurred in the procurement of the original patent which has rendered the original patent "inoperative or invalid". Everything permitted by the statute stems from an *inadvertence, accident, or mistake*. If none such has occurred, no valid reissue patent may be granted.

With an understanding of the requirements of the statute, let us next recite the pertinent historical facts of the Wheeler patent upon which its invalidity is here asserted.

#### **History of the Patent.**

Wheeler filed application for patent for the invention here involved on July 7, 1927. Thereafter, on Nov. 13, 1930, a divisional application was filed. This divisional application, on Sept. 27, 1932, matured as patent No. 1,879,863. This is the "original" patent which was reissued as the patent in suit.

The original patent formed the basis of a series of suits in New York, to which reference has already been made. We are now concerned with but one of them, namely *Hazeltine v. Abrams et al., supra*, which was instituted in the Eastern District of New York in May, 1934. On August 6, 1934, Judge GALSTON found the patent to be invalid, and entered a decree dismissing the complaint. Plaintiff appealed from that decree, and, *while its appeal was pending* (to wit: on Sept. 26, 1934) the application for reissue was filed. The appeal was prosecuted by plaintiff, resulting, as we have already shown (*ante*, p. 2), in the unanimous



decision of the Court of Appeals for the Second Circuit (per Judge LEARNED HAND) that the patent was invalid because it did not disclose a patentable invention.

On the foregoing facts, the statutory reasons for invalidity of the reissue patent will now be separately established.

- (A) The invalidity of the original patent, because it did not disclose a patentable invention, could not be cured by reissue.

As has been stated, the statute expressly limits any reissue patent that may be granted thereunder to "the same invention" as that of the original patent. Therefore, as a matter of simple logic, if a patent has been adjudicated invalid because it discloses *no* patentable invention, obviously, reissuance of the patent cannot make the invention patentable. The cases uniformly so hold. A contrary rule would permit the Patent Office, an administrative bureau, to review *ex parte* and reverse the decisions of the Federal Courts, including this Court.

Earlier cases are reviewed in *Erickson v. Frink Co.*, 16 Fed. (2d) 498,\* and the rule is there succinctly stated (at p. 500) as follows:

"Erickson's proposition, that a reissue of a patent conclusively held 'wholly invalid' is itself void, was sustained by the Circuit Court of Appeals for the Third Circuit in a careful opinion by Circuit Judge BUFFINGTON in *Penn Elec. & Mfg. Co. v. Conroy*, 185 F. 511, and also by District Judge GODDARD in the Southern District of New York in an opinion dated July 15, 1926, *Traitel Marble Co. v. Hungerford Brass & Copper Co.*, 16 F. (2d) 495. The doctrine of these

\* This case was reversed on jurisdictional grounds (20 Fed. (2d) 707).

opinions is plainly applicable to the instant case. It seems sound. The original patent was not 'inoperative or invalid, by reason of a defective or insufficient specification.' R. S. Sec. 4916 (Comp. St. Sec. 9461). It was invalid, because it disclosed no invention."

In *Penn Electric & Manufacturing Co. v. Conroy*, cited in that case, the Third Circuit Court of Appeals, after a careful review of the reissue statute, succinctly stated,

"An adjudged lack of patentability is not made by the statute a ground for reissue."

Likewise, in the cited case of *Traitel Marble v. Hungerford Brass & Copper Co.*, the Court stated:

"Therefore, if the original patent was invalid for the lack of the disclosure of invention, it follows that reissue patents would continue to be invalid."

It here follows, therefore, that the Wheeler reissue patent is invalid.

The Sixth Circuit Court of Appeals below disregarded the simple, indisputable logic of this principle by accepting, as "squarely controlling", its own prior decision in *Van Kannel Revolving Door Co. v. Winton Hotel Co.*, 276 Fed. 234, in which this principle was in no sense presented or involved. The Court apparently had no answer to the clear, logical decision in *Erickson v. Frink Co.*, *supra*, and therefore ignored it. The Court did, however, seek to differentiate from the decision in *Penn Electric & Mfg. Co. v. Conroy*, *supra*, on the assertion that that case involved and was based on the issue of *res judicata*, for which assertion the opinion in the Third Circuit case affords no support whatever. It was suggested, however, by the Second Circuit Court of Appeals in *Traitel Marble Co. v. Hungerford Brass & Copper Co.*, 18 Fed. (2d) 66, which reversed the decision of the District Court, above quoted from, on a process of reasoning which we submit is illogical and unsound.

(B) The reissue patent was improvidently granted by the Patent Office, because no facts were presented with the application therefor from which it could have been determined that "inadvertence, accident or mistake" occurred in the procurement of the original patent.

Under ordinary circumstances, decisions of the Commissioner of Patents on matters affecting his administrative duties are not reviewed by the Courts. However, where compliance with statutory requirement is involved, the rule is otherwise.

This Court long ago (in *Mahn v. Harwood et als.*, 112 U. S. 354) stated:

"It was not intended then and is not now, to question the conclusiveness, in suits for infringement of patents, of the decisions of the Commissioner on questions of fact necessary to be decided before issuing such patents, except as the statute gives specific defenses in that regard. But the statutory defenses are not the only defenses which may be made against a patent. Where it is evident that the Commissioner, under a misconception of the law, has exceeded his authority in granting or reissuing a patent, there is no sound principle to prevent a party, sued for its infringement, from availing himself of the illegality, independently of any statutory permission so to do."

With this introduction, we next refer to the oath filed by Wheeler with his application for reissue.

The only material allegation of the oath is (III, 1061):

"the insufficiency consists particularly in the absence of claims in the express language of claims 12 to 17

\* See also *Union Switch & Signal Co. v. Louisville Frog, Switch & Signal Co.*, 73 Fed. (2d) 550 (C. C. A. 6); *Firestone Tire & Rubber Co. v. U. S. Rubber Co.*, 79 Fed. (2d) 948 (C. C. A. 6).



inclusive submitted herewith, and that the defect or insufficiency which renders such patent partly inoperative arose from inadvertence or mistake and without any fraudulent or deceptive intention on his part."

From this it will be seen that *not one single fact is recited showing, or even tending to show, that an inadvertence, accident or mistake in the procurement of the original patent had occurred.*

It is likewise of interest to note that there was filed with the application for reissue a printed copy of the original patent which had been amended in ink and by typewriter (III, 1030-1049), and it is significant that no amendment or cancellation of claims 1, 5, 6, and 10 of the patent (held invalid by Judge GALSTON) was made. The significance of this fact will be apparent later. Indeed, only one of the twelve claims of the patent (namely claim 9) was cancelled, and six additional claims were presented. It is obvious, therefore, that there was here no "inadvertence, accident or mistake" as to any of the remaining claims of the original patent, which were *deliberately and intentionally* retained in the application, while the validity of four of them was being vigorously asserted in the Court of Appeals.

The Examiner, on July 19, 1935, called attention to the insufficiency of the oath (III, 1076), citing the decision in *Union Switch & Signal Co. v. Louisville Frog*, 73 Fed. (2d) 550, and Wheeler, in response (and after the invalidating decision of the Court of Appeals in the *Abrams* case) filed what he termed an "Amended and Supplemental Oath" (III, 1102-1106). In this oath there was injected, for the first time, the averment that the patentee had claimed "as his own invention or discovery more than he had a right to claim as new", identified in the following language (p. 1103):

"That the parts improperly claimed in said patent are original claims 1, 5, 6, 9, and 10".

From this it will be seen that although Hazeltine had vigorously fought for the validity of the claims of the original patent through the District Court and the Circuit Court of Appeals, it was *now* asserted, after an adverse decision in that litigation, *that that decision* created an "inadvertence, accident or mistake" in the procurement of the original patent.

The specific errors constituting the alleged inadvertence, accident or mistake, and how they arose, are then asserted to be recited in the supplemental oath in compliance with Rule 87(d) of the Patent Office (III, 1104-1106). In order to emphasize that these averments are mere "pretense . . . too bald for human credence" (as was the case with respect to the reissue patent before this Court in *Miller v. Brass Co.*, 104 U. S. 850, 351), we enumerate all of them below in the order recited in the oath.

1. On January 3, 1926 the patentee completed and successfully operated a radio receiver.
2. An application was filed by Wheeler's attorneys on July 7, 1927, Serial No. 203,879 (the parent application hereinbefore identified).
3. The said application disclosed the circuit arrangement of the radio receiver.
4. The original patent sought to be reissued likewise disclosed the circuit of the radio receiver and the mode of operation thereof.
5. The parent application and the original patent also disclosed other circuits which might be employed.

6. *The patentee was not versed in the construction of patent claims.* (This assertion was utterly false as was conclusively proven and will be hereinafter shown.)
7. The claims allowed in the original patent were brought to the patentee's attention by the attorneys for the Hazeltine Corporation before the patent issued.
8. The claims seemed to the patentee to define and protect his invention.
9. *That it was not until Judge GALSTON rendered his decision in the Abrams case, invalidating certain of the claims, that the patentee "became apprised that certain of these claims did not define his invention and did not distinguish from what others had done, and that said patent did not have sufficient and proper claims to protect his invention"*.

(We interrupt here to again point out that the application for reissue was filed *subsequent* to Judge GALSTON's decision, and no cancellation of or amendment to the claims held to be invalid by Judge GALSTON was made; indeed, no mention of Judge GALSTON's decision was made.)

10. The opinion of Judge GALSTON was rendered August 6, 1934 (the application for reissue was filed Sept. 26, 1934).
11. *"That as promptly thereafter as possible a revision of the specifications and claims of said patent was undertaken in order to correct the error that had been made"*.

(This, again, was utterly false for, as we have already pointed out, the application for reissue did *not* purport to cancel or amend the claims invalidated by Judge GALSTON. Indeed, the truth was that Hazeltine continued the prosecu-



tion of its appeal from Judge GALSTON's decision, vigorously asserting the correctness of the specifications and the validity of the claims, *and did not cancel them from the reissue application until more than a year later.*)

12. That on September 26, 1934 the present application for reissue was filed.
13. That on July 29, 1935 the Court of Appeals for the Second Circuit rendered its decision affirming the decree of the District Court.
14. That the amendments to the specifications and claims which were submitted with the "Amended and Supplemental Oath" were also made in the light of the opinion of the Court of Appeals.

*This is all that the oath recites on the subject.* It will be conclusively seen therefrom that there was no inadvertence, accident or mistake of any kind or nature whatsoever recited as having occurred in the procurement of the original patent.

That is not all. The patentee, Wheeler, is the Chief Consulting Engineer of Hazeltine (I, 28). He was produced as a witness by Hazeltine, and testified at length to the entire historical development of his alleged invention (I, 28-54). Not one word of testimony was offered—and not one word of evidence appears in the record adduced at the trial of the case—to indicate or even suggest that any "inadvertence, accident or mistake" occurred in connection with the procurement of the original patent. To the contrary, it was established that Wheeler's patent attorneys, who prepared his original application and solicited the patent from the Patent Office (and who represent Hazeltine in this case), were unusually skilled in the radio art, and the particular attorney (Mr. Baldwin Guild) who prepared and prosecuted

the original application *devoted his entire time to radio matters* (Findings 13-19, II, 843, 844); that Wheeler himself had become a patent expert before the patent issued (Finding 6, II, 841); and that Wheeler's application was prosecuted with the utmost care and attention by both Wheeler and Guild (Findings 14-19).\*

On the foregoing, we again assert that the history of the patent—the file wrapper of the original patent, the file wrapper of the reissue patent, and the record in this case—is entirely silent as to any “inadvertence, accident or mistake” ever having occurred which would legally warrant a valid reissue of the original patent, or which supports the validity of the reissue patent. Little can be said in support of a statement of this kind. If the record is silent, that is all that there is to it. It is always possible, however, to show the contrary if the facts permit. This Hazeltine has not done in the Courts below and cannot do here.

It follows, therefore, that the reissue patent is invalid because it has been improvidently granted in that no “inadvertence, accident or mistake” was shown to have occurred—and such showing was an essential prerequisite to its valid grant. (Cf. *Firestone Tire & Rubber Co. v. U. S. Rubber Co.*, 79 Fed. (2d) 948, at 960).

The Court below said (III, 1474):

“It (Detrola) relies upon the fact that the *original* oath filed with the petition for reissue recited

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\* It should be noted that these findings of fact by Judge LEDERLE were not made by resolving contested issues or weighing conflicting evidence. To the contrary, *they were carefully prepared by counsel and agreed to as correctly reciting the facts.* Indeed, in the preamble to the findings (II, 838) the Court stated:

“*Counsel for both parties have agreed to the following findings of fact.*”

Moreover, they were based on Wheeler's own testimony given from the witness stand (I, 28-54).

no facts tending to show inadvertence, accident or mistake \* \* \*."

This statement is directly contrary to fact, and betrays a most distressing inattention to Detrola's position. The fact is that the present section of our brief is a substantial repetition of the corresponding section of our brief below, in which we listed the same 14 numbered averments of the *supplemental* oath. Furthermore, the entire testimony on this point (I, 21-54) and the agreed findings on this point (II, 838) were all directed to the *supplemental* oath.

- (C) The reissue patent was improvidently granted by the Patent Office, because the oath accompanying the application for reissue affirmatively establishes that no "inadvertence, accident or mistake" occurred in connection with the issuance of the original patent, and the only material averments were false.

The above analysis of the reissue oath shows that the only substantial reason advanced as a justification for the reissue was that the New York Courts had declared the original patent to be invalid, notwithstanding Hazeltine's most strenuous and persistent efforts to induce a different conclusion.

In the final analysis, the most that could be said is that the patentee and his attorneys committed an error in judgment in seeking to enforce the original patent. But that is not an "error" contemplated by the reissue statute. Nor is it an inadvertence, accident or mistake incident to the procurement of the original patent. As the Court of Appeals for the Seventh Circuit put it in a case involving facts



substantially the same as those here present (*Heidbrink v. Hardissen*, 25 Fed. (2d) 8 C. C. A. 7).

"Accidental or inadvertent action cannot be predicated upon conduct properly characterized as deliberate or designed";

and later said of the patentee:

"Seeking too much, he lost all. Nevertheless, if he did so deliberately and intentionally and successfully, he can hardly be heard to say that he acted inadvertently, accidentally or by mistake."

In the present case, factual basis for an allegation of inadvertence, accident or mistake was so completely lacking that Hazeltine and the patentee were compelled to resort to the desperate expedient of falsifying. Thus, in the only respects in which the allegations of the oath were at all material to the subject of inadvertence, accident or mistake, they were utterly false, as has been previously indicated and will now be more fully pointed out.

In the first place, the application for reissue was filed subsequent to the decision of Judge GALSTON of the Eastern District Court of New York in the *Abrams* case, in which claims 1, 5, 6, and 10 were held to be invalid. Notwithstanding this fact, however, no mention of Judge GALSTON's decision was made in the application, or the oath accompanying the application (III, 1050). On the contrary, this information was deliberately suppressed (III, 1052). Indeed, as has already been pointed out (*ante*, p. 38), none of the invalidated claims was cancelled or amended in the slightest respect.

It will be seen, therefore, that while it was asserted in the "supplemental" oath that the reissue was applied for to correct "errors" called to the attention of the patentee by the decision of Judge GALSTON, the indisputable fact is

that the application for reissue was *not* predicated on any such thing.

The Court below completely failed to understand this point, saying:

"Prior to the decision in the Second Circuit appellant had applied for a reissue in which the scope of the original claims was narrowed substantially in accordance with the suggestions of the District Court . . ."

As we have just shown, *Hazeltine had done no such thing*. The Court below also said:

"The Court in the *Hazeltine* case (7 Fed. Supp. at 914), had stated that Wheeler, in the original patent, had claimed more than he had a right to claim as new, and Wheeler, in his application for reissue conceded the fact and relied on it."

*This, again, is directly contrary to the facts.*

In the next place, only two of the fourteen statements of the oath (Nos. 6 and 11, *ante*, p. 40) had even a remote bearing on the subject, and both of these statements were false. The first of them was that the patentee was not versed in the construction of patent claims. The precise language is (III, 1105):

"that although he was not versed in the construction of patent claims, the claims finally allowed (and subsequently issued in said Patent No. 1,879,863) were brought to his attention by the attorneys for Hazeltine Corporation before the patent issued; that they then seemed to him to define and protect his automatic amplification control invention which had been embodied by him in said radio receiver."

Of course, the purpose of such an assertion is obvious. It was to convey the idea that the patentee had been imposed upon, misled or misinformed because he was not

*familiar with patent claims.* Surely, thought Hazeltine, the Patent Office could be induced to the conclusion that an honest mistake had been made if it was predicated upon the inexperience of and lack of familiarity with patent matters by the inventor. The facts of the matter are, however, as Wheeler was forced to admit at the trial (II, 841-842), that prior to the issuance of the original patent he had served as a patent expert in radio patent litigation, having testified regarding radio patents and prior art in a case entitled *Lester L. Jones v. Freed-Eiseman Radio Corporation* in April 1929, at which time he understood radio patents. Again, in the case of *Hazeltine Corporation v. American Bosch Magneto Corporation*, in the U. S. District Court for the Southern District of New York, in or about November 1930, in which he testified that he was familiar with patents, particularly in the radio art; and that he had studied a number of patents prior to 1930, and had had experience with patent claims; and that prior to 1931 he had applied for a number of patents pertaining to the radio art, of which twenty-two issued as patents assigned to the Hazeltine Corporation, and all of which had been prepared and prosecuted by the solicitors for plaintiff Hazeltine Corporation, who solicited the Wheeler original and reissue patents.

The only other material averment was that *as promptly after Judge GALSTON's opinion as possible* a revision of the specification and claims was undertaken to correct the error that had been made. We have shown above that the particular claims held invalid by Judge GALSTON were repeated *verbatim* in the reissue application, filed Sept. 26, 1934. They were not cancelled or amended until Sept. 4, 1935 (III, 1078), *nearly a year later, and more than a year after Judge GALSTON's opinion.*



An entirely separate consideration, which, independently of all other facts of the case, crystallizes the utter falsity of Hazeltine's position, and exposes the vicious abuse of the Reissue Statute here attempted, exists in the fact that the Courts below have been told, and the Sixth Circuit Court of Appeals has held (III, 1478-9) that Wheeler's real invention consisted of the the use of an a.a.c. circuit employing the combination of a *diode rectifier* and a *high resistance*, and that the reissue was necessary or warranted *because this had not been claimed by the original patent*. The simple fact is that *precisely this was claimed by claim 11 of the original patent (III, 1075)*. Wheeler and Hazeltine thought so little of this combination—now advanced as Wheeler's invention—that it was not even included among the claims sued on in the New York litigation. In fact, Wheeler and Hazeltine thought so little of this combination that it was never claimed during the prosecution of the application for the original patent (for reasons already made clear, *ante*, pp. 31, 32) until August, 1932—*five years after the application had been filed (III, 1189)*, and after claims to a diode detector had been repeatedly rejected, and *all such claims canceled from the application*.

Furthermore, there is not a single word in the opinions in the Second Circuit that supports in any way, or to any extent whatsoever, the suggestion that those courts taught Wheeler that what he should have claimed was a *diode detector with a high resistance*. On the contrary the Second Circuit Court of Appeals expressly held (74 F. (2d) 331):

"Again as to Wheeler's triode used as a diode, it was an old device; *Heising had used a diode in a not dissimilar setting* and that is not to be distinguished from a triode used as a diode."

As we have shown above (*ante*, p. 21), Heising *concededly* disclosed diode a.a.c. with a "high" resistance.

Still further, the representation that Wheeler's "invention" is in the use of a diode is a direct *repudiation* of his original patent rather than a reissue thereof for the *same* invention (see *ante*, p. 18).

It is submitted, therefore, that it has been affirmatively shown that no inadvertence, accident or mistake occurred in the procurement of the original patent, so that the reissue patent has been improvidently granted and is invalid.

**(D) The reissue patent is invalid, because of laches in applying for it.**

This Court in *Miller v. Brass Co.*, 104 U. S. 350, after holding invalid the reissue patent there involved because it was not for the same invention as the original patent, proceeded to say (p. 351):

"There is another grave objection to the validity of the reissued patent in this case."

In explanation of this statement this Court later in its opinion said:

"But it must be remembered that the claim to a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed. It is a declaration that that which is not claimed is either not the patentee's invention, or if his, he dedicates it to the public. This legal effect of the patent cannot be revoked unless the patentee surrenders it and proves that the specification was framed by real inadvertence, accident or mistake, without any fraudulent or deceptive intention on his part; and this should be done with all due diligence and speed. *Any unnecessary laches or delay in a matter thus apparent on the record, affects the right to alter or reissue the patent for such cause.*"

Later, in *Topliff v. Topliff*, 145 U. S. 156, this Court stated that a patentee could validly reissue his patent only (p. 172):

“provided it is evident that there has been a mistake and he has been guilty of no want of reasonable diligence in discovering it, and no third persons have in the meantime acquired the right to manufacture or sell what he had failed to claim.”

Assuming (contrary to the facts) that there had been inadvertence, accident or mistake in the present case which would have justified a reissue with the claims now appearing in the patent, this is truly a case in which the alleged error is, in the above words of this Court, “a matter . . . apparent on the record” in which *any* delay would be legally inexcusable.

The original patent issued on September 27, 1932. The application for reissue was not filed until September 26, 1934—one day less than two years thereafter. Thus, throughout all that time no action was taken to correct an alleged “error”, which, if it existed at all, was apparent on the face of the patent.

It is quite true that laches must be determined from the facts and circumstances of each particular case, and because thereof no fixed period of elapsed time has been judicially or otherwise established. However, many reissue patents have been invalidated on this ground for delays shorter than that here present. Thus, in *Coon v. Wilson*, 113 U. S. 268, the patent was invalidated because of a delay of only ninety-seven days in applying for reissue. Again, in *Parker Co. v. Yale Clock Co.*, 123 U. S. 87, the reissue patent was invalidated because of a delay of a year and eight months.

It seems self evident, therefore, that where, as here, the reissue was assertedly to cure an “error” discoverable on



mere examination of the patent, the delay here deliberately and intentionally indulged in by plaintiff (to permit litigation on the original patent), namely, of one day less than two years—was unreasonable, and constitutes such laches as to invalidate the patent.

Nor can such laches be excused on the theory advanced by the Court of Appeals below, namely, that the error was not discovered until the Second Circuit Court of Appeals had rendered its adjudication. The claims of the original patent were challenged by the answer filed in the *Abrams* case on May 24, 1934. If, as the patentee later implied in his reissue oath, he was basking in the glow of false security up to that time, the answer in that suit was surely legal notice of the necessity of taking the corrective step. No such step was taken, however. To the contrary, plaintiff stood on the original patent and sought its enforcement throughout the trial in the District Court, and by prosecution of appeal to the Court of Appeals.

In support of what we assert to be its wholly erroneous conclusion that Wheeler was entitled to litigate his claims and secure an adverse decision before being put to the necessity of applying for a reissue, the Court of Appeals below cited a number of cases, the most relevant of which is that of this Court in *Triplett v. Lowell*, 297 U. S. 638. But it is believed that those authorities have nothing whatever to do with the matter here under consideration. In *Triplett v. Lowell*, *supra*, the question was whether or not a patentee is required to disclaim subject matter held to be invalid by a Court of last resort, and this Court decided that he was

not; he could thereafter sue on the invalid claim in another jurisdiction, subject to the penalty of having his entire patent declared invalid for unreasonable delay in disclaiming if he was there unsuccessful. It is self evident that this is not the issue here—a fact which the Court of Appeals completely lost sight of. There can be no question but that, under the doctrine of *Triplett v. Lowell*, Wheeler could have petitioned this Court for a writ of certiorari in the New York case, or could have *retained* his original patent and sued an infringer in another jurisdiction on the claims which had been invalidated by the Second Circuit Court of Appeals. *He did neither of these things.* To the contrary, he reissued his patent, in effect alleging as “inadvertence, accident or mistake” in the procurement of the original patent the decision of the Second Circuit Court of Appeals adverse to his persistent contentions throughout the New York litigation. No rule of law, authority or statute permits any such thing. Its absurdity and the falsity of its premise are believed to be self evident; and its utter disregard of the public interest is quite brazen. A patentee cannot blow both hot and cold. He may not have his attention called to the invalidity of his patent and litigiously assert its validity, and, when he has been judicially declared wrong in his contentions, *then* assert that it was an “inadvertence, accident or mistake” that he *promptly*, without unreasonable delay, after knowledge thereof, has corrected. (Cf. *Milloy Electric Co. v. Thompson-Houston Electric Co.*, 148 Fed. 843 C. C. A. 6).

On the foregoing it is submitted that the reissue patent is invalid because of laches in applying for it.

#### POINT IV.

Detrola has intervening rights in that its receivers, charged to infringe, are identical in every material respect with the receivers it manufactured prior to the application for the reissue patent, as well as with the *Colonial* receivers held not to infringe the original patent, in which holding Hazeltime acquiesced.

This Court has had recent occasion to consider this defense in a patent infringement suit (*Sontag Chain Stores v. National Nut Co. of California*, 310 U. S. 281). Here, as in the *Sontag* case, misuse of the reissue statute has been attempted. After Wheeler received his patent grant, and a device had been marketed which did not infringe the patent (as judicially determined in the *R. E. B.* case, *supra*), the patentee has obtained a reissue with claims which, it is asserted, the *identical* instrumentality now infringes. In view of the clear and decisive character of this Court's salutary decision in the *Sontag* case, it is deemed to be here merely necessary to recite the facts of the case at bar, which, alone, will show the complete applicability of that decision.

These facts are:

1. Prior to the application for reissue of the original Wheeler patent, Detrola was manufacturing and selling radio receivers identical in every material respect, insofar as the automatic amplification control circuit is concerned, with the two receivers here charged to infringe, and Detrola continuously, since then, has manufactured receivers employing that identical circuit (I, 213, 303, 304). This will be seen by reference to the a.a.c. circuits of the Detrola receivers manufactured prior to the application for reissue,



simplified diagrams of which are Defendant's Exhibits CC and DD, reproduced in Volume III of the record, pages 1348 and 1349. A comparison thereof with the a.a.c. circuits charged to infringe (Defendant's Exhibits U and V, pages 1340 and 1341) establishes their identity (Kelley, I, 304).

2. That same circuit was employed in the "Colonial" receivers (Kelley, I, 302-303). Indeed, Detrola's Chief Engineer came to it from Colonial (another RCA licensee) and continued its use by Detrola (I, p. 351). This will be seen by comparing the Detrola a.a.c. circuits (pp. 1340 and 1341) with the Colonial circuit (p. 1347).

3. The Colonial receivers were charged to infringe the original Wheeler patent in the *R. E. B.* case in the Eastern District of New York, which resulted in a decree dismissing the complaint for non-infringement (8 Fed. Sup. 100). Plaintiff acquiesced in that judgment and never appealed therefrom, and never again asserted the original patent against that a.a.c. circuit.

From the foregoing simple facts it is asserted, regardless of all other issues in the case, that Detrola has intervening rights—even personal estoppel—which preclude forever the assertion of the reissue patent against Detrola's continued manufacture and sale of the a.a.c. circuit employed in its receivers here charged to infringe.

The Court below completely ignored these dispositive facts, on the erroneous theory that the doctrine of the *Sontag* case was inapplicable to a "narrowing" reissue. Of course, there is no justification whatever, either in the *Sontag* opinion or in the principles upon which it was based, for any such limitation on the doctrine therein announced by this Court.

**Conclusion.**

**The judgment of the Sixth Circuit Court of Appeals below should be reversed, and the cause remanded to the District Court of the Southern Division for the Eastern District of Michigan with instructions to dismiss the complaint, with judgment against Hazeltine for Detrola's costs sustained in the cause.**

Respectfully submitted,

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**APPENDIX.**

Sec. 4916. (U. S. C., title 35, sec. 64.) Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the reissued patent, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in the case of a



machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

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